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EXAMINER

NERANGIS, VICKEY MARIE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/657,687
Filing Date: September 08, 2003
Appellant(s): REA ET AL.

Jacques Miles
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/2/2009 appealing from the Office action mailed 5/7/2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

6,207,625	Ogano et al	3-2001
3,898,168	Brehm	8-1975
2,833,717	Whitacre	5-1958
6,444,624	Walker et al	9-2002
3,876,550	Holubec	4-1975

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogano et al (US 6,207,625) in view of Brehm (US 3,898,168) or Whitacre (US 2,833,717).

Ogano et al discloses a lubricant oil composition comprising sulfurized oxymolybdenum dithiocarbamate which is 400-2,000 ppm Mo (col. 4, lines 7-52); zinc dialkyl dithiophosphate which is 700-2000 ppm P (col. 4, line 53 to col. 4, line 22); and other additives such as 1-30 wt % viscosity index improver (col. 6, lines 34-41), pour point depressants (col. 6, lines 41-47), 0.1-15 wt % ashless dispersants such as polybutenyl succinimide (col. 6, lines 48-55), metallic detergents such as calcium salts of sulfonates and phenates (col. 6, lines 56-61), phosphorus-free antioxidants (col. 6, lines 61-66), antifoaming agents (col. 7, lines 38-40), and 0.01-3 wt % rust inhibitors such as alkenyl succinic acid half ester, fatty acid soap, and polyalcohol, and alkyl polyoxyethylene ether (col. 7, lines 32-36). The base oil is like those presently used and would intrinsically provide for the presently claimed NOACK volatility of less than 15%. The

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composition is used in diesel engines and it therefore would have been obvious to use the lubricant composition in a four-cycle marine engine which would require such a heavy-duty engine lubricant.

Ogano et al fails to disclose the use of specific rust inhibitors like presently claimed.

Brehm discloses a lubricant oil for use in multigrade oil formulations and teaches that a common antirust agent is an alkyl-phenoxyethoxy ethanol having 3-12 ethoxy groups (col. 2, lines 38-68).

Whitacre discloses corrosion-inhibiting lubricating oil and teaches that a polyethoxylated alkylphenol such as polyoxyethylated isononylphenol is desirably used as the anti-rust additive (col. 2, lines 13-51).

Given that Ogano et al discloses a lubricant composition open to the use of a variety of known anti-rust agents and further given common anti-rust agents in lubricant compositions taught by Brehm and Whitacre, it would have been obvious to one of ordinary skill in the art to utilize a plurality of known anti-rust agents in the lubricant composition of Ogano et al, absent a showing of surprising or unexpected results. It is well settled that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

Claims 1-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,444,624) in view of Holubec (US 3,876,550) and further in view of Brehm (US 3,898,168) or Whitacre (US 2,833,717).

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Walker et al discloses a lubricant comprising having a Noack volatility of less than 15 comprising (col. 1, lines 34-67) one or more molybdenum-containing additives such as molybdenum dithiocarbamates (col. 4, line 6) providing for an amount of elemental molybdenum not greater than 1000 ppm; a calcium detergent additive such as sulfonates or phenates (col. 4, line 55); and other additives ((col. 5, line 24 to col. 6, line 51) including ashless dispersants such as hydrocarbon-substituted succinimides (0.1-20 mass %), phosphorus-free antioxidants, anti-wear agent such as zinc dialkyl dithiophosphate (0.1-6 mass %), viscosity modifier (0.01-6 mass %), anti-rust agent (col. 6, line 40), antifoam agent (col. 6, line 41), and a flow improver (col. 6, line 41). See Table in col. 7 for amounts of additives. The composition is used in diesel engines and it therefore would have been obvious to use the lubricant composition in a four-cycle marine engine which would require such a heavy-duty lubricant.

Walker et al fails to disclose specific anti-rust agents, i.e., rust inhibitors.

Holubec discloses lubricant compositions and teaches common anti-rust additives (col. 3, line 63 to col. 6, line 49; col. 12, line 56 to col. 13, line 9) such as aliphatic hydrocarbon-substituted succinic acids and anhydrides (col. 4, lines 6-25) and reaction product of hydrocarbon-substituted succinic acids or anhydrides with alkylene glycol (col. 6, lines 8-13) which can be used in mixtures (col. 3, lines 49-55).

Brehm discloses a lubricant oil for use in multigrade oil formulations and teaches that a common antirust agent is an alkyl-phenoxy polyethoxy ethanol having 3-12 ethoxy groups (col. 2, lines 38-68).

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Whitacre discloses corrosion-inhibiting lubricating oil and teaches that a polyethoxylated alkylphenol such as polyoxyethylated isononylphenol is desirably used as the anti-rust additive (col. 2, lines 13-51).

Given that Walker et al discloses a lubricant composition open to the use of a variety of known anti-rust agents and further given common anti-rust agents in lubricant compositions taught by Holubec, Brehm, and Whitacre, it would have been obvious to one of ordinary skill in the art to utilize a plurality of known anti-rust agents in the lubricant composition of Walker et al, absent a showing of surprising or unexpected results. It is well settled that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972).

(10) Response to Argument

Appellant argues that the prior art fails to disclose a rust inhibitor system that provides for superior rust performance.

There is no improper picking and choosing because the examiner has only taught in specific known anti-rust agents for lubricants into a lubricant composition already disclosed to contain anti-rust agents. Case law holds that the selection of a known material based on its suitability for its intended use supports *prima facie* obviousness. *Sinclair & Carroll Co vs. Interchemical Corp.*, 325 US 327, 65 USPQ 297 (1045).

While not one prior art references teaches the combination of two rust inhibitors like presently claimed, case law holds that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d

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506,509, 173 USPQ 356, 359 (CCPA 1972). Therefore, given that the prior art references teach the presently claimed rust inhibitors, it would have been obvious to one of ordinary skill in the art utilize a combination of two or more, absent a showing of unexpected or surprising results with respect to the combination. The examples of the instant specification provide little to no probative value, given that only combinations of 4 mole ethoxylate of nonyl phenol, dodecyl(tetrapropyl) succinic acid, and glycerol oleates are exemplified and there are no comparative examples which use only one rust inhibitor.

It is noted that the affidavit filed 4/2/2009 (on the same date as the Appeal Brief) has not been entered given that it does not overcome all rejections under appeal and no showing of good and sufficient reason why the affidavit was not earlier presented has been made. 37 CFR 41.33. Even had the affidavit been entered, the data would have been insufficient to overcome all rejections under appeal given that the data is not reasonably commensurate in scope with the scope of the claims for two reasons. First, the examples only include blends of ethoxylated C₄-C₁₈ alkyl phenol having 2-10 moles of ethylene oxide per mole (rust inhibitor (i)) and C₈-C₂₂ alkyl or alkenyl succinic acid or anhydride (rust inhibitor (iv)) and not rust inhibitors (ii) or (iii) like presently claimed. Second, only a 50:50 blend is exemplified, wherein it has not been established if the unexpected result with rust inhibitor (iv) is also present when mixed in ratios not 50:50 such as 95:5 or 25:75. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Vickey Nerangis/
Examiner, Art Unit 1796

Conferees:

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796

/David Wu/
Supervisory Patent Examiner, Art Unit 1796